

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following arguments is respectfully requested.

Claims 1, 4-5 and 11-12 have been amended. No new matter has been added as a result of these amendments.

Drawings

The Examiner indicated that a Petition under 37 C.F.R. Section 1.84(a)(2) needed to be granted in order to allow the use of the color photographs as drawings. Applicant herewith encloses such a Petition and three (3) sets of drawings. Applicant respectfully requests that this Petition be granted.

Duplicate Claims

The Examiner stated that if claims 4 and 5 were found to be allowable that claims 11 and 12 would be objected to as being substantially duplicate thereof. Applicants submit that in view of the amendments to claims 4-5 and 11-12 herein that this objection has now been rendered moot.

Claim Rejection – Double Patenting

The Examiner rejected claims 4, 6, 7, 9, 11, 13, 14 and 16 under the judicially created doctrine of obviousness-type double patenting and being unpatentable over claim 1 of U.S. Patent No. 12, 536. In view of this rejection, Applicant herewith encloses a terminal disclaimer and requisite fee. In view of the submission of this terminal disclaimer, Applicant submits that this rejection should now be withdrawn.

Claim Rejections – 35 U.S.C. Section 101

The Examiner states that the disclosed invention is inoperative and therefore lacks utility. More specifically, the Examiner states that claims 5 and 12 recite a plant which has BFP-100 or a derivative in its pedigree. The Examiner states that “[B]ut the cited method says to cross *Lobelia erinus* with *Lobelia valida* and BFP-100 is neither. So it is impossible to produce a plant as claimed.” Applicant submits that in view of the amendments to claims 5 and 12 that this rejection is now moot and should be withdrawn.

Claim Rejections – 35 U.S.C. Section 112, Second Paragraph

Claims 1-17 are rejected under 35 U.S.C. Section 112, second paragraph as being indefinite for failing to particularly point out and distinctly claims the subject matter regarded as the invention. More specifically, the Examiner stated that claims 1 and 11 were indefinite and condusing in the use of “regenerating”. Applicant has amended claims 1 and 11 and replaced “regenerating” with the term “growing”. In view of the amendments to claims 1 and 11, Applicant submits that this rejection is now moot and should be withdrawn.

Claims 5 and 12 are rejected as being indefinite for the reasons discussed in the 35 U.S.C. Section 101 rejection. In view of the amendments to claims 5 and 12, Applicant submits that this rejection is now moot and should be withdrawn.

Written Description – 35 U.S.C. Section 112, First Paragraph

Claims 4-17 are rejected under 35 U.S.C. Section 112, first paragraph as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully traverse this rejection.

Claim 4 has been amended to recite that the interspecific *Lobelia* plant produced by the method of claim 1 has a semi-trailing habit. Claim 5 is dependent upon claim 4 and refers specifically to BFP-100. Claims 6-10 are dependent upon claims 4 or 5. Claim 11 has been amended to recite that the interspecific *Lobelia* plant produced by the claimed method has a semi-trailing habit. Claims 12-17 are dependent upon claim 11. Applicant submits that the specification adequately describes how to produce an interspecific *Lobelia* plant having a semi-trailing habit and hence provides a sufficient written description to enable one skilled in the art to which it pertains to make and/or use the invention. Therefore, this rejection should be withdrawn.

Enablement – 35 U.S.C. Section 112, First Paragraph

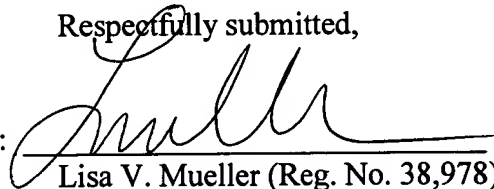
Claims 5-10 and 12 are rejected under 35 U.S.C. Section 112, first paragraph as not being enabled by the specification. Specifically, the Examiner states that seeds of BFP-100 need to be deposited with a recognized depository pursuant to the Budapest Treaty. Applicants wish to hold making such a deposit in abeyance until receipt from the Examiner of notification of allowable subject matter.

In view of the aforementioned amendments and arguments, Applicant submits that claims 1-17 are now in condition for allowance.

If any additional fees are incurred as a result of the filing of this paper, authorization is given to charge deposit account number 23-0785.

Respectfully submitted,

By:



Lisa V. Mueller (Reg. No. 38,978)
Attorney for Applicant

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
200 MADISON STREET
SUITE 3800
CHICAGO, IL 60661
(312) 876-1800

MARKED UP VERSION SHOWING CHANGES MADE

Please amend claims 1, 4-5 and 11-12 as follows:

Claim 1. (Amended). A method of producing an interspecific *Lobelia* plant, the method comprising the steps of:

- d. crossing a *Lobelia erinus* with a *Lobelia valida*;
- e. recovering the resulting F₁ hybrid interspecific *Lobelia* seed;
- f. planting the F₁ hybrid interspecific *Lobelia* seed and [regenerating] growing into plants; and
- d. selecting an interspecific *Lobelia* plant.

Claim 4. (Amended). An interspecific *Lobelia* plant produced by the method of claim 1 having a semi-trailing habit.

Claim 5. (Amended). The interspecific *Lobelia* plant of claim 4 wherein said plant [has a pedigree which includes] is BFP-100 [or derivatives thereof].

Claim 11. (Amended). An interspecific *Lobelia* plant having a semi-trailing habit and produced by a [the] method comprising the steps of:

- a. crossing a *Lobelia erinus* with a *Lobelia valida*;
- b. recovering the resulting F₁ hybrid interspecific *Lobelia* seed;
- c. planting the F₁ hybrid interspecific *Lobelia* seed and [regenerating] growing into plants; and
- d. selecting an interspecific *Lobelia* plant having a semi-trailing habit.

Claim 12. (Amended). The interspecific *Lobelia* plant of claim 11 wherein said plant [has a pedigree which includes] is BFP-100 [or derivatives thereof].